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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,138	02/18/2004	Kevin Corcoran	ORM / 242US	3385
26875 7590 12/28/2007 WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			EXAMINER PICKETT, JOHN G	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 12/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/781,138

Applicant(s)

CORCORAN ET AL.

Examiner

Greg Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 49 is/are allowed.
- 6) ☒ Claim(s) 33-37, 40-45, 47, 48 and 50-55 is/are rejected.
- 7) ☒ Claim(s) 38, 39 and 46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 October 2007 has been entered.

Claims 33-55 are new and pending in the application. Claims 1-32 have been canceled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Observations***

3. In accordance with MPEP 2111.01, during examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004).

Independent claim 33: The terminology, "for storing, in bulk, tooth-positioning orthodontic appliances and facilitating the setup of individual orthodontic cases" is an intended use recitation, as is the passage, "configured to rigidly and removably support

a plurality of tooth- positioning orthodontic appliances or one or more packages thereof.”

Claim 33 does not require the appliances or the set-up tray.

Independent claim 43: The claim appears to invoke the provisions of 35 USC 112, 6<sup>th</sup> paragraph. As best determined and shown in Figure 3A, the means for restraining is recess 43 and the means for holding is a plurality of recesses 44. The only structure recited in the claim is the tray, the means for restraining, and the means for holding. The appliances and set-up tray are recited only as an intended use of the tray.

### ***Claim Objections***

4. Claims 47, 48, 50 are objected to because of the following minor informalities:

The preambles of claims 47 and 48 recite a system; however the claims depend from claim 44, which recites an organizer.

In claim 50, line 6, the phrase, “the orthodontic set-up tray a plurality” is grammatically incorrect.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. Claims 47 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 recites the limitation "each carrier" in line 3. There is insufficient antecedent basis for this limitation in the claim. Claim 47 is presumed to depend from claim 46.

Claim 48 is dependent upon claim 47 and is rejected for the above reason.

***Claim Rejections - 35 USC § 102***

6. Claims 33, 34, 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Perfect (US 4,085,845).

Claim 33: Perfect discloses an appliance organizer tray 1 comprising a generally horizontal, upwardly facing surface 24, a support 32 that is capable of holding an unspecified and unclaimed set-up tray in the manner claimed, and a plurality of holders 5 and 6 that are capable of removably supporting packages of orthodontic appliances as claimed.

Claim 34: Perfect discloses support 32 as a rectangular recess bounded by four edges. Perfect is capable of functioning as claimed.

Claim 43: Perfect discloses a tray 1, means for restraining 32, and means for holding 5 & 6. The means for restraining and means for holding are the functional equivalents of the structures disclosed by the applicant and are capable of functioning as claimed.

7. Claims 33, 34, 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Georgakis (US 4,898,276).

Claim 33: Georgakis discloses a tray 11 with a generally horizontal upwardly facing surface 18/19, an orthodontic set-up tray support 21, and a plurality of holders 23 capable of holding a plurality of tooth-positioning orthodontic appliances.

Claim 34: Georgakis discloses support 21 as a rectangular recess bounded by four edges. Georgakis is capable of functioning as claimed.

Claim 43: Georgakis discloses a tray 11 with a means 21 for restraining a set-up tray and a means 23 for holding a plurality of appliances. The means for restraining and means for holding are the functional equivalents of the structures disclosed by the applicant and are capable of functioning as claimed.

### ***Claim Rejections - 35 USC § 103***

8. Claims 35 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Georgakis (US 4,898,276) in view of applicant's admitted prior art.

Georgakis suggests the provision of a set-up tray for orthodontic appliances placed within support 21 (see 4:1-11). Georgakis, as applied to claims 33 and 43 above, discloses the claimed invention except for the details of the set-up tray. As denoted in Figure 1 of the instant application, applicant admits that a set-up tray with the claimed features was known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Georgakis with a set-up tray as disclosed by Prior Art Figure 1 of the instant application and suggested by Georgakis in order to enable pre-selection of the appliances prior to use (see paragraph [0027] of the instant application).

9. Claims 36, 37, 40, 45, 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Georgakis-PA as applied to claims 35 and 44 above, and further in view of Chester et al (US 5,350,059).

Georgakis teaches arranging the holders to correspond with the dental arches of a patient and a plurality of appliances within each holder 23 for retaining appliances for each individual tooth (at 4:1-7). One of ordinary skill in the art would recognize this arrangement as retaining substantially identical appliances within each holder 23. Georgakis-PA, as applied to claims 35 and 44 above, discloses the claimed invention except for the holders holding the appliances in the same orientation.

Chester teaches the provision of packaged group 20 (see Figure 3) of a plurality of individual packages 22 of appliances 24, with the group being arranged in the same predetermined orientation. The packages are grouped and labeled to identify the tooth for which the appliances are intended (see e.g. 6:13-22 and Figure 5). One of ordinary skill in the art would recognize this grouping as retaining substantially identical appliances. Chester also teaches the provision of grooved recesses for receipt of the grouped appliances in a predetermined orientation (see Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the loose compartments 23 of Georgakis with grooved recesses and individually packaged appliances as taught by Chester in order to enable individual sealing of the appliances. Such a replacement would have the appliances arranged as claimed.

10. Claims 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Georgakis-PA-Chester as applied to claims 50-52 above, and further in view of Roberts (US 622,396).

Georgakis-PA-Chester, as applied to claims 50-52 above, discloses the claimed invention except for the base. Roberts teaches a compartmented base B/B' for storing a plurality of extra articles beneath an upper tray A. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tray of Georgakis-PA-Chester with a base as claimed in order to store extra sets of articles. The base of Roberts is compartmented and capable of retaining a supply of set-up trays.

11. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Georgakis as applied to claim 33 above, and further in view of Roberts (US 622,396).

Georgakis, as applied to claim 33 above, discloses the claimed invention except for the base. Roberts teaches a compartmented base B/B' for storing a plurality of extra articles beneath an upper tray A. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tray of Georgakis with a base as claimed in order to store extra sets of articles. The base of Roberts is compartmented and capable of retaining a supply of set-up trays.



***Allowable Subject Matter***

12. Claim 49 appears to define over the available prior art and is allowed.
13. Claims 38, 39, and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
14. Claims 47 and 48 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
15. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Response to Arguments***

16. Applicant's arguments with respect to claims 33-55 have been considered but are moot in view of the new ground(s) of rejection.

Applicant should note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Further, it has been held that the recitation that an element is "configured to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

### ***Conclusion***

17. It is respectfully noted that the applicant's claim language is very close to reciting a product and process within the same claim (see MPEP 2173.05(p)(II)). Care should be taken by the applicant when amending the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Greg Pickett/  
Examiner  
Art Unit 3728